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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,762	12/11/2003	John B. Enns	VTN 568 CIP3	1967

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EXAMINER	
WEBB, WALTER E	
ART UNIT	**PAPER NUMBER**
1612	

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01/29/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/734,762	ENNS ET AL.	
	Examiner	Art Unit	
	WALTER E. WEBB	1612	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on *06 January 2009*. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-22 and 24-35*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 12/15/2008
13. ☐ Other: _____.

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612

/Walter E Webb/
Examiner, Art Unit 1612

Continuation of 11. does NOT place the application in condition for allowance because: Applicants arguments are not commensurate in scope with the invention as claimed. Applicants argue tht curing under reaction conditions sufficient to provide the recited reactivity ratio is critical to achieving the desired loading of silver in the resulting antimicrobial lens. Applicants invention as claimed requires any monomer of Formulas I, II, III, or IV, each representing a potentially huge genus of monomers. Applicants data shows only a limited number of monomers tested, i.e. CYST (N,N-bis(acryloyl)cystamine and HEMA (hydroxymethyl methacrylate). There is no reasonable basis for predicting the similar results with other monomers. Applicant's data also shows specific initiator ratios, i.e. 0.45, 0.90, and 1.35. Applicant claims where the reactivity ratio is "at least about 0.45" which is inclusive of numbers less than or greater than 0.45. Applicant also claims recite "at least about' in regard to initiator concentration and intensity. Traditionally, the term "about" permits some tolerance. See, e.g., In re Ayers, 69 USPQ 109 (CCAP 1946), where "at least about 10%" was held to be anticipated by a teaching of a content "not to exceed about 8%." Note, however, that the courts have recently begun to interpret the term far more expansively. See, e.g., Conopco v. May, 24 USPQ2d 1721, 1736 (U.S. District Court, Eastern District of Missouri 1992), where four times was found within scope of "about", where the components of the respective compositions perform substantially the same function in substantially the same manner. As stated in the first action on the merits, because Monostere teaches silver nitrate and a photoinitiator and intensity which closely meets the concentrations of the claims, the ratio was found to be reasonably expected. Applicant's data also shows that incorporation of silver nitrate into the lens is complete when the initiator is at a concentration of 1.35 ppm, and that incorporation of silver nitrate is incomplete 61.9% to 72.9% when the initiator is at a low or intermediate concentration. Applicant does not specifically claim an initiator concentration of 1.35ppm. Instead, applicant claims the initiator concentration at about 0.4%, 0.9% and about 0.4 to about 2% (claims 32-35). Since Lai et al. teach adding the initiator in the same relative proportions, i.e. 2%, once the silver nitrate is sprayed on the lens as described in Monestere, the lens would be reasonably expected to incorporate the appropriate amounts of silver. Applicant argues that the initiator concentration alone does not insure the desired reactivity ratio. However, the purpose of the experiment is to incorporate a high percentage of silver into the lens. As per applicants specification, incorporation of silver nitrate into the lens is complete at a particular initiator ratio. Applicant argues that specific conditions must be met in order to achieve the desired percentage of silver in the lens, but the claim limitations read broadly in regard to these conditions. Applicants arguments are unpersuasive insofar as they are not commensurate in scope with the invention as claimed.

Applicant also argues that the silliver nitrate is physiologically inert, as stated in Monestere et al., not antimicrobial. However, silver nitrate is physiologically inert insofar as in will not react chemically in the eye. This is does not mean silver nitrate is not antimicrobial. As long as silver nitrate is capable of being an antimicrobial agent it would make a contact lens antimicrobial if it is part of the contact lens.